REMARKS

This response is in reply to a final Office Action dated May 26, 2004 (The "Office Action"). Claims 1-30 are pending. It is requested that this response be entered because it adds no new matter nor raises any new issues. MPEP Section 706.07(e) specifically allows an Examiner to admit a response if it "will place the application either in condition for allowance or in better form for appeal." The same section also empowers the Examiner to withdraw a final rejection if new reasons are presented such as to convince the Examiner that previously rejected claims are in fact allowable.

The Examiner combined the newly cited Zank et. al reference (US 5,420,379, "Zank") with previously cited art in rejecting claims 1-30. Because Zank cannot be fairly combined with any reference with which it is joined in making such rejections, the Examiner has failed to establish a Prima Facie case in rejecting claims 1-30. Thus, applicant respectfully disagrees with the rejection, and asks that it be withdrawn.

The rejection to claims 1-26 and 30 all include combining Japanese Laid Open publication P2001-159948A to Shimono (Shimono) with Zank. The rejection to claims 27-29 combine Tien (GB 2,314,470) with Zank. Because such proposed modifications would modify the principles of operation of the prior art and render it unsatisfactory for its intended purpose, this rejection fails to make a Prima Facie case, and the applicant respectfully requests that the rejection is withdrawn.

MPEP section 2143.01 states:

> If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

In the present rejection, Shimono is apparently directed to a method of transferring power from a planar coil in a mousepad to a planar coil in a mouse for the purpose of powering a cordless to eliminate the need for a battery. (See TECHNICAL PROBLEM section of Shimono). Tien is directed to a mouse rechargeable power supply and a charging device (Tien, Page 1, lines 4-6).

The pending independent claims all include reference to a solenoid (claims 1, 23, 27) or a non-planar loop (claim 14), but Shimono and Tien fail to teach such features.

Zank is added to Shimono in rejecting claims 1-26 and 30 as teaching use of a coil. Zank is added to Tien in rejecting claims 27-29 as teaching use of a coil.

However, Zank's coil is directed toward a *positional transducer* for a graphical stylus.

> "The present invention is directed to an electromagnetic transducer, an exemplary configuration of which forms a graphic tablet that provides digital coordinate data for a computer or similar system in response to operator control." (Zank, Column 8, lines 8-12).

The Office Action states that the benefit of combining Zank with Shimono or Tien is "ultimately increasing accuracy, repeatability, range and resolution" (Office Action, paragraphs 8, 20, and 30).

No such benefit is realized by the combination, however, as claimed embodiments of the invention are directed toward a system for "transferring electrical power" (Claim 1), for "supplying power to a computer mouse" (Claim 14), of "powering a computer peripheral device" (Claim 23), of "recharging a rechargeable battery in a computer mouse" (Claim 27).

Thus, "a benefit of increased accuracy, repeatability, range and resolution" has no relevance to the claimed invention because none of these factors, which all describe transferring data, has any effect on how to build a system for transferring electrical power. Thus there is no motivation to combine Zank with Shimono or Tien to achieve claimed embodiments of the invention because the Examiner has shown no desirable benefits that would be obtained for embodiments of the invention.

Further, combining Zank with Shimono or Zank with Tien renders the prior art unsatisfactory for its intended purpose -- a practice that is specifically prohibited by the MPEP section 2143.01 cited above. In other words, adding the positional transducer coil properties of Zank to Shimono or Tien would not enhance the already-developed power transmitting systems of Shimono or Tien, but rather they would simply be parallel systems - one for power and one for positional data. In fact, both of these references refer to their planar coil assemblies as a positive factor in their design. Paragraph [011] of Shimono

speaks of the benefit of having a wire coil because it causes relatively low electromagnetic radiation. Tien's abstract, last line, speaks of the desirability for planar spiral coils. Thus, adding Zank's positional coils does nothing to enhance Shimono and Tien in transmitting power to a mouse, and in fact only adds additional cost without additional benefit.
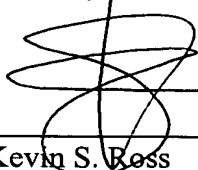
Further, adding power transmitting properties of Shimono or Tien to Zank would destroy the positional qualities of Zank, because both Shimono and Tien's systems are designed to transmit electrical power, and not to transmit stylus coordinates. Thus, combining Zank with Shimono or Tien renders Zank unsatisfactory for its intended purpose.

Therefore, as described in section 2143.01 of the MPEP, no Prima Facie case for combining Zank with either Shimono or Zank has been made. Correspondingly, the Applicants respectfully request that this rejection be withdrawn and that claims 1-30 be allowed.

For the foregoing reasons, reconsideration and allowance of claims 1-30 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.
Attorneys for Intel Corporation

Kevin S. Ross
Reg. No. 42,116

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
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Ilka Dalton